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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,184	03/14/2001	Kenji Ohshima	Q63509	2848

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/805,184	<b>Applicant(s)</b> OHSHIMA ET AL.	
	<b>Examiner</b> Christopher P Bruenjes	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20031215</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**WITHDRAWN REJECTIONS**

1. The 35 U.S.C. 102 rejections of claims 1-2 and 4-5 as anticipated by Lammers of record in Paper #5, Pages 5-6 Paragraph 7, and Paper #8, Page 5 Paragraph 10, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.
2. The 35 U.S.C. 102 rejections of claims 1-2 and 4-5 as anticipated by Nedstedt of record in Paper #5, Page 5 Paragraph 6, and Paper #8, Page 4 Paragraph 9, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.
3. The 35 U.S.C. 103 rejections of claims 1-6 over Nedstedt in view of Adams et al of record in Paper #5, Pages 7-8 Paragraph 8, and Paper #8, Pages 5-7 Paragraph 11, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.
4. The 35 U.S.C. 112 rejections of claims 1-6 and 18-20 of record in the Office Action mailed November 6, 2003, Pages 3-4 Paragraph 6, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.

5. The 35 U.S.C. 102 rejection of claim 18 as anticipated by Lammers in the Office Action mailed November 6, 2003, Page 5 Paragraph 7, has been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.

6. The 35 U.S.C. 102 rejections of claims 18-19 as anticipated by Nedstedt in the Office Action mailed November 6, 2003, Pages 6-7 Paragraph 8, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.

7. The 35 U.S.C. 103 rejection of claim 20 over Nedstedt alone or in combination with Adams et al of record in the Office Action mailed November 6, 2003, Pages 13-14 Paragraph 13, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.

8. The 35 U.S.C. 102 rejections of claims 1-2, 4-5, and 18 as anticipated by Roder of record in the Office Action mailed November 6, 2003, Pages 7-8 Paragraph 9, have been withdrawn due to Applicant's amendments in the Paper filed February 6, 2004.

**REPEATED REJECTIONS**

9. The 35 U.S.C. 103 rejections of claims 3 and 6 over Roder in view of Adams et al of are repeated for the reasons previously of record in the Office Action mailed November 6, 2003, Pages 9-11 Paragraph 10.

10. The 35 U.S.C. 103 rejection of claim 19 over Roder is repeated for the reasons previously of record in the Office Action mailed November 6, 2003, Pages 11-12 Paragraph 11.

11. The 35 U.S.C. 103 rejection of claim 20 over Roder is repeated for the reasons previously of record in the Office Action mailed November 6, 2003, Pages 12-13 Paragraph 12.

**NEW REJECTIONS**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-2, 4-5, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kewin (USPN 4,874,139).

Kewin anticipates a printable sheet roll cartridge comprising a sheet rolled in a tubular manner to form a sheet roll having a hollow portion therein (reference number 12, Figure 1 and abstract). The cartridge further comprises a target (reference number 26, Figure 1) disposed in the hollow portion (as shown in Figure 3), said target is configured to inherently provide information to identify the type of said sheet roll, wherein the type of said sheet roll comprises at least one of a material of said sheet roll, a thickness of said material, a width of said material, a quantity of winding of a said material forming said sheet roll and a sensitivity of said material. The target inherently provides this information because if the collar (reference number 14, Figure 1) did not have the correct configuration, the target would not fit in the paper roll cartridge. Therefore, the only the specific sheet material that is wound on a core tube having the correct collar (reference number 14, Figure 1) would fit the target and therefore the target provides information to identify if the type of said sheet roll is correct for the machine. The target is located in the core tube (Figure 3) and the target has an opening formed therein (reference numbers 30 and 32, Figure 1).

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The target is located at the either end of the sheet roll, so therefore is located at one of a plurality of predetermined positions and the sheet roll is discriminated by determining which end the target is located. The target blocks an entire diameter of the hollow portion at the end of the roll as shown by reference number 34, Figure 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-2, 4-5, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roder (USPN 6,334,587).

Roder teaches a printable sheet roll cartridge comprising a sheet rolled in a tubular manner to form a sheet roll having a hollow portion therein that includes a tube or core (see abstract). A holder (reference number 7, Figure 2) and cylinder-shaped or disk-shaped code carrier (reference number 12, Figure 2) are disposed within the hollow portion (col.2, 1.10-20). The holder and code carrier combined define the target of the instant invention. The holder and code carrier provide information to identify the type of said sheet roll (see abstract and col.3, 1.28-31). The holder is formed in a star-shape (col.2, 1.14), and therefore has an opening formed therein (reference number 6, Figure 2). The target is located at one of a plurality of predetermined positions, such as first position B or second position C (col.2, 1.25-30). The limitation that "the type of the sheet roll is discriminated by determining in which of said predetermined positions said target is located" is an intended use of the target, and therefore receives little patentable weight because articles are defined by structure alone and Roder teaches the structural limitations required by claim 5. One of ordinary skill in the art would have recognized that the target is placed in certain locations within the core



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tube to provide the user with sight confirmation of particularities of the paper web material. The holder and code carrier combined is also a "means for providing information as to identify the type of said sheet roll", for same reasons as discussed above for how the holder and code carrier combined is a target.

Roder fails to explicitly teach that the target is configured to provide information with regard to the material, width, thickness, quantity of winding, or the sensitivity of the material. However, Roder teaches that the target provides other data besides location, such as the particularities of the paper itself (col.3, 1.28-31). One of ordinary skill in the art would have recognized that any data with respect to the particularity of the paper such as material, thickness, width, quantity of winding, or the sensitivity of the material is entered into the code carrier of the target depending on the intended end result of the target, as taught by Roder.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to provide load specific data with respect to the particularity of the paper such as material, thickness, width, quantity of winding, or the sensitivity of the material into the code carrier of the target of Roder, depending on the intended

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end result or information desired of the roll cartridge, as taught by Roder.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kewin (USPN 4,874,139).

Kewin teaches all that is claimed in claim 1 but fail to explicitly teach that the sheet roll is formed from stencil sheet. However, Kewin teaches that the sheet roll is a roll of newsprint paper (col.1, 1.5-10), but does not specifically teach that the paper is stencil paper. However, one of ordinary skill in the art would have recognized that any paper web or sheet could be used to form this paper roll around a winding core.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to select stencil as the paper used in forming the paper roll taught by Kewin, since it has been held that a one of ordinary skill in the art would select a known material on the basis of its suitability for the intended use of the paper roll, absent the showing of unexpected result. See *In re Leshin*, 125 USPQ 416.

15. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kewin (USPN 4,874,139) in view of Adams et al (USPN 4,852,823).

Kewin teaches all that is claimed in claim 1, but fail to teach that the target is colored one of a plurality of predetermined colors. However, Adams et al teach that the type of sheet or yarn roll is determined by coloring a "target" one of a plurality of predetermined colors (col.3, 1.20-47). Adams et al specifically teaches that the color of the "target" is an indicium for a particular characteristic of the yarn, such as the type of yarn, or the source, etc. Therefore, Adams et al teaches that the color of the "target" is used to teach the characteristics or type of the yarn roll, just as Kewin teaches that the "target" is used to teach the characteristics or type of the sheet roll.

One of ordinary skill in the art would have recognized that Adams et al is analogous to Kewin, because the inventions are similar in structure and function. Both a bobbin for yarn and a core for a sheet roll are structurally similar as tube for wrapping a sheet around it and functionally they are both used to roll and unroll sheets of material. Also, it has been held that in a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into

other areas where one of ordinary skill in the art would be aware that similar problems exist. One of ordinary skill in the art would have recognized that bobbins would have the same problem of determining what type of material is wrapped around the bobbin.

One of ordinary skill in the art would have also recognized that the color scheme of Adams et al is another equivalent method of identifying the type of said sheet roll as Kewin's target, and that the target of Kewin would be colored to give a quick visual indication of the type of sheet roll, as taught by Adams et al along with the information provided by the reader.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to color the target of Kewin one of a plurality of predetermined colors, in order to provide the sheet roll with a quick visual indication of the type of sheet roll, as taught by Adams et al.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

16. Applicant's arguments regarding the 35 U.S.C. 112 rejections of claims 1-6 and 18-20 of record have been considered but are moot since the rejections have been withdrawn.

17. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, and 5 as anticipated by Lammers have been considered but are moot since the rejections have been withdrawn.

18. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, and 5 as anticipated by Nedstedt have been considered but are moot since the rejections have been withdrawn.

19. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 18 as anticipated by Lammers have been considered but are moot since the rejection has been withdrawn.

20. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 18 and 19 as anticipated by Nedstedt have been considered but are moot since the rejections have been withdrawn.

21. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1-2, 4-5, and 18 as anticipated by Roder

have been fully considered but are moot since the rejections have been withdrawn.

22. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-6 over Nedstedt in view of Adams et al have been considered but are moot since the rejections have been withdrawn.

23. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 19 and 20 over Roder have been considered but are not persuasive.

In response to Applicant's argument that Roder fails to explicitly teach a target that blocks an entire diameter of a hollow portion of paper web, diameter is defined as a straight line segment passing through the center of a figure, especially of a circle or sphere, and terminating at the periphery. If the star-shaped holder has six points the points opposite each other would form an entire diameter that is blocked. Although other diameters cutting through portions between each point would provide a gap having no portion blocking those diameters, the scope of the claim only requires that one entire diameter of the hollow portion is blocked.

In response to Applicant's argument regarding claim 1, attention is directed to the new 103 rejections over Roder.

24. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 20 over Roder have been considered but are moot since the rejection has been withdrawn.

### **Conclusion**

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Oshima (USPN 6,390,428).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB

March 23, 2004

*CPB*

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

*3/29/04*